

that the independent claims are indefinite. This process of dribbling out new rejections is contrary to **MPEP 707.02** and **MPEP 706**.

In fairness to the long-suffering Applicant, if the claims prove to be patentable over the prior art currently of record, the Examiner should promptly pass this application on to allowance and issue.

2. Allowed Claims/Subject Matter

Applicant does note with appreciation that the Examiner has indicated the subject matter of claims 7 – 8 and 16 - 19 are patentable, and would be allowable if rewritten in independent form.

3. § 112 Rejections

The Examiner has rejected claims 1 – 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for, among other things, lack of antecedent basis in the claims. The Examiner points out that in each of the independent claims the term “said session” is recited. Applicant points out that each independent claim recites “an Internet Protocol (IP) telephony session...” in the preamble. It is the only “session” referred to in the claim. Thus, the term “said session” clearly points back to the phrase “an Internet Protocol (IP) telephony session...” recited in the preamble. There is clear antecedent basis for the phrase “said session.” Applicant notes that the Examiner did not find this claim phrasing objectionable in the earlier Office Actions, and does not understand why this issue is being raised now.

With respect to claim 3, the Examiner’s rejection (Paragraph 3, lines 6 – 9) employs non-standard English that cannot be understood. Applicant assumes that the Examiner does not understand the claim. Claim 3 merely recites subject matter that is disclosed in the specification and drawings. Namely, that the first device is assigned a temporary IP proxy address that is used by the called party to identify the first device. In the same way, the caller identifies the second device using another temporary IP proxy address. Again, Applicant notes that the Examiner did not find this claim phrasing objectionable in the earlier Office Actions, and does not understand why this issue is being raised now.

4. § 103 Rejections

A. The Examiner has rejected claims 1 – 6, 9 – 12, 15, and 20 – 24 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,081,513 [Roy] in view of U.S. Patent No. 5,828,844 [Civanlar et al., hereinafter Civanlar]. The Applicant respectfully traverses the rejection because the Examiner has failed to make a prima facie case of obviousness because the Examiner has failed to show where each element of the claimed invention is found in the cited references. Further, the Examiner has failed to provide a proper motivational statement for combining the references.

Claim 1 is directed to a method for providing quality of service in an Internet Protocol (IP) telephony session between a calling party and a called party. The method includes the step of transporting IP telephony media for the session between the calling party and a first device. The first device has IP telephony capability and ATM capability. IP telephony media for the session is transported between the called party and a second device. The second device also has IP telephony capability and ATM capability. An ATM virtual circuit is established for the session between the first device and the second device. The data path for the telephony session is secured by the use of proxy addressing. The step of securing the data path by proxy addressing is described in great detail on pages 5 – 7, and also shown in detail in Figure 2.

Claim 5 is directed to a method for providing quality of service in an IP telephony session between a calling party and a called party. The method includes the steps of assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A switched virtual circuit is established for the session between the first access control manager and the second access control manager.

Claim 12 is directed to a method for providing quality of service in an IP telephony session between a calling party and a called party. The method includes the steps of assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A temporary second network calling party address is assigned for said session at said first access control manager. Finally, a temporary second network calling party address is assigned for said session at said second access control manager.

Claim 20 is directed to a system for providing a quality of service IP telephony session between a calling party and a called party. The system includes an IP telephony network. The IP telephony network provides IP telephony access to the calling party and to the called party. The system also includes an ATM network. A first device is connected between said IP telephony network and said ATM network. The first device provides bi-directional translation between IP media traffic and ATM traffic. A second device is connected between said IP telephony network and said ATM network. The second device provides bi-directional translation between IP media traffic and ATM traffic. An intelligent control layer establishes a virtual circuit through said ATM network for an IP telephony session between the calling party and the called party, whereby the first device and the second device are assigned on a per session basis.

Roy is directed to a wide area network that includes the interconnection of customer premise LANs via an ATM wide area network. Routers are disposed between the IP networks and the ATM network. The routers are configured to encapsulate the IP packets to transfer the data over the ATM network. The configuration of Roy is very similar to the arrangement described in the background section of the present invention. The problem associated with Roy, and with the approach discussed in the background of the invention, is that (1) possible destination IP addresses need to be provisioned in the router ahead of time, and, (2) it is not possible to define which IP flow should get the ATM service and which should get the IP best efforts service. In other words, when a destination address is provisioned in the router, then all traffic to that destination address will be carried by the ATM virtual circuit.

Civanlar discloses a system and method for establishing communications over a client-server network using internet protocol (IP) switches. Civanlar discloses a network that is comprised of IP switches that are configured to operate using both IP and ATM protocol (See Figure 3, col. 5, line 59 – col. 6, line 9). Clients may employ dial-up services, or may directly access the IP switches (See Figure 3, col. 5, lines 62 – 67). Clients may request special services by accessing a proxy-server. The proxy server is typically a Web-server that is administered by an Internet Service provider (Col. 6, lines 10 – 15). The client accesses the web-server by using a web-browser that is secured by a password. Once access is secured, the client “conveniently selects the service attribute from a list provided on the browser” (Col. 6, line 15 – 20). For example, the client may select ATM services, non-ATM services, dial-

up services, ISDN services, an IP address of an Internet host, an Intranet name, billing numbers, credit card information, or filter information (Col. 6, lines 21 – 34).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A.) The Examiner fails to point out where all of the claim limitations are taught or suggested in the cited references.

Claim 1:

Applicant notes that the Examiner has failed to point out where the cited references perform any of the method steps recited in claim 1. The Examiner is required to perform this essential task and he has not. There is simply no discussion of claim 1 in the Examiner's action, or of any method claim. As a result, the Examiner fails to make a *prima facie* case of obviousness because he fails to point out where any of the method steps recited in claim 1 are taught or suggested in the cited references.

Claim 5:

Applicant notes that the Examiner has failed to point out where the cited references perform any of the method steps recited in claim 5. A *prima facie* case of obviousness requires that the Examiner show where the references teach every claim element. The Examiner has ignored all of the method steps recited in claim 5. Thus, the Examiner fails to make a *prima facie* case of obviousness because he fails to point out where any of the method steps recited in claim 5 are taught or suggested in the cited references.

Claim 12:

Applicant notes that the Examiner has failed to point out where the cited references perform any of the steps recited in claim 12. Again, there is simply no discussion of claim 12

in the Examiner's action. The Examiner must provide an independent examination for each claim and he has not. As a result, the Examiner fails to make a prima facie case of obviousness because he fails to point out where any of the method steps recited in claim 12 are taught or suggested in the cited references.

Claim 20:

The Examiner asserts that router 3-1, as disclosed by Roy in col. 4, lines 24 - 31, is "a first device connected between said IP telephony network and said ATM network, the first device providing bi-directional translation between IP media traffic and ATM traffic," as recited in claim 20. However, col. 4, lines 24 - 31 states that "routers 3-1...encapsulate IP over the ATM protocol...(emphasis added)." Anyone of ordinary skill in the art will recognize that the verb "encapsulate" is quite different than the verb "translate." When a payload is encapsulated within a packet it is, by definition, not translated. Those of ordinary skill in the art know that routers are configured to direct packets through the network without examining or translating the contents of the packets for throughput reasons. Information flow in the network would grind to a halt if each router in the network translated the contents of each packet passing through. Thus, the Examiner has failed to point out where Roy teaches the "first device" as recited in claim 20. The Examiner admits that Civanlar does not disclose this feature either.

Claim 20 also recites a second device that is "connected between said IP telephony network and said ATM network, the second device providing bi-directional translation between IP media traffic and ATM traffic." The Examiner again relies on Roy, col. 4, lines 24 - 31, and states that router 3-3 is the "second device" recited in claim 20. For the same reasons provided in the paragraph above, router 3 - 3 cannot be the recited "second device." As a result, the Examiner has failed to point out where Roy teaches the "second device" as recited in claim 20. The Examiner admits that Civanlar does not disclose this feature either.

Claim 20 recites "an intelligent control layer for establishing a virtual circuit through said ATM network for an IP telephony session between the calling party and the called party, whereby the first device and the second device are assigned on a per session basis." The Examiner admits that MMB 7, as disclosed in col. 3, line 45 - col. 4, line 5, does not teach the recited element. The Examiner then argues that Johnson teaches a proxy server in col. 8, lines 3 - 15. With all candor, the Applicant is confused because the Examiner rejected the

claims over Roy in view of Civanlar. The Johnson reference is not identified by the Examiner and the Applicant should not be forced to speculate as to what the Examiner meant when he promulgated the Office Action.

Accordingly, the Examiner has failed to make a prima facie case of Obviousness with respect to claim 20.

B.) There is no motivation to combine Roy and Civanlar

As stated above, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner states that "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made [sic] to implement the proxy scheme into Roy for securing in the communication network and establish QoS guarantees for the communication."

There is no prima facie case for obviousness because the Examiner has failed to point out where in the references this suggestion can be found. Alternatively, the Examiner has failed to point out where the suggestion can be found in the knowledge generally available to one of ordinary skill in the art. The Examiner's reason for combining the references involves impermissible hindsight. The U.S. Court of Appeals for the Federal Circuit has emphasized that the Examiner cannot employ hindsight when combining references. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant respectfully submits that the Examiner's statement for combining the references is a restatement of the Applicant's claimed invention (see preamble of claim 12 and claim 20) and the field of the invention stated in the Background of the Invention (See first paragraph of the Background section).

For the above reasons, the applicant respectfully asserts that claims 1 – 24 are patentable under 35 U.S.C. § 103(a).

5. Conclusion

Based upon the above remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-24 and a prompt Notice of Allowance thereon.

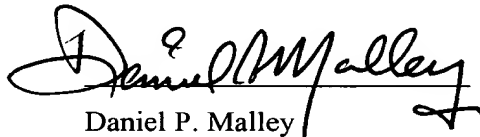
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to WorldCom Deposit Account **13-2491**.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

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